



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

5 SEGAL

Serial No. 09/997,855

Filed: November 29, 2001

10 For: Mechanical Apparatus and  
Method for Dilating and  
Delivering a Therapeutic Agent  
to a Site of Treatment

Examiner: Unknown

Group Art Unit: 3763

Attorney Docket: 70802.01

San Diego, California

Date: 09/25/02

#8  
Amdd B  
S. Byer  
1/2/04

**RESPONSE TO OFFICE ACTION**

15 Mail Stop – Non-Fee Amendment  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED  
DEC 22 2003  
TECHNOLOGY CENTER R3700

20 Sir/Madam:

In response to the Office Action postmarked September 22, 2003, having a shortened statutory period for response set to expire early on October 22, 2003, having a statutory expired on March 22, 2004, please enter the following amendments and remarks:

1) Election of species and subspecies begin on page 3 of this paper.

2) Amendments to the Claims are reflected in the listing of claims which begins on page 8 of this paper.

2) Amendments to the Specification begin on page 26 of this paper.

3) Amendments to the Drawings begin on page 27 of this paper.

4) Remarks/Arguments begin on page 28 of this paper.

**ELECTION OF SPECIES:**

5       The Examiner stated that Claims 1-13 and 31-34 are generic to a plurality of disclosed patentably distinct species comprising:

      Species I, representative of an apparatus for mechanically dilating and passively delivering medicament to an obstruction.

10       Species II, representative of an apparatus for mechanically dilating and utilizing iontophoresis and/or electroporation for delivering a medicament to an obstruction.

15       Species III, representative of a rapid exchanged designed mechanical dilatation and medicament delivery device.

20       The Examiner required the Applicants, in accordance with 35 U.S.C. 121, to elect a single disclosed species, even though this requirement is traversed.

**Response:**

25       The Applicants elect Species II, representative of an apparatus for mechanically dilating and utilizing iontophoresis and/or electroporation for delivering a medicament to an obstruction. The Applicants will withdraw claims directed towards Species I, representative of an apparatus for mechanically dilating and  
30       passively delivering medicament to an obstruction and Species III, representative of a rapid exchanged designed mechanical dilatation and medicament delivery device. However, the Applicants assert that the withdrawn claims may be prosecuted under a continuation or divisional application.

**ELECTION OF SUBSPECIES:**

5       **The Examiner stated that once the Applicant elects either Species I or II, then the following election of a primary subspecies and a secondary subspecies is required.**

**As to Claims 1-13 and 31-34 are generic to a plurality of disclosed primary subspecies comprising:**

10       **Primary Subspecies A, depicted in Figure 13.**

**Primary Subspecies B, depicted in Figure 14.**

15       **Primary Subspecies C, depicted in Figure 15.**

**Claims 1-13 and 31-34 are generic to a plurality of disclosed patentably distinct secondary subspecies comprising:**

20       **Secondary Subspecies 1, depicted in Figure 11.**

**Secondary Subspecies 2, depicted in Figure 12.**

25       **The Examiner required the Applicants, in accordance with 35 U.S.C. 121, to elect a single disclosed primary subspecies and a single disclosed secondary subspecies, even though this requirement may be traversed.**

**Response:**

5       The Applicants elect primary subspecies B, depicted in Figure 14 and  
secondary subspecies depicted in Figure 11. The Applicants will withdraw claims  
directed towards primary subspecies A and C and secondary subspecies 2. However,  
the Applicants assert that the withdrawn claims may be prosecuted under a  
continuation or divisional application.

10       **SUPPLEMENTAL ELECTION OF SUBSPECIES:**

15       Additionally, if Applicants were to elect Species II, then the following  
supplemental election of subspecies is required.

20       Claims 1-13 and 31-34 are generic to a plurality of disclosed patentably distinct  
subspecies comprising:

Subspecies I, depicted in Figure 8A.

25       Subspecies II, depicted in Figure 8B.

Subspecies III, depicted in Figure 8C.

30       Subspecies IV, depicted in Figure 8D.

Subspecies V, depicted in Figure 8E.

35       Subspecies VI, depicted in Figure 8F.

The Examiner required the Applicants, in accordance with 35 U.S.C. 121, to elect a single disclosed subspecies, even though this requirement is traversed.

**Response:**

The Applicants elect subspecies I, depicted in Figure 8A. The Applicants will withdraw claims directed towards subspecies II, III, IV, V, and VI. However, the Applicants assert that the withdrawn claims may be prosecuted under a continuation or divisional application.

**FURTHER ELECTION OF SUBSPECIES:**

The Examiner stated that additionally, if Applicants were to elect Species II, then they would be required to elect a primary subspecies, a secondary subspecies and supplemental subspecies (if applicable), then the following election of subspecies is required.

This application contains claims directed to the following patentably distinct subspecies of the claimed invention:

Subspecies AA, iontophoretic means, claims 35-38.

Subspecies BB, electroporation means, claims 39-40.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed subspecies for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1-13 and 31-34 generic.

**Response:**

The Applicants elect subspecies AA, iontophoretic means, claims 35-38. The Applicants will withdraw claims directed towards subspecies BB, electroportation means, claims 39-40. However, the Applicants assert that the withdrawn claims may be prosecuted under a continuation or divisional application.

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